

BEST AVAILABLE COPY**REMARKS/DISCUSSION OF ISSUES**

Claims 1-20 are presently under examination. The subject matter of claims 21-24 is the subject matter of a divisional application filed concurrently.

Provisional Double Patenting Rejection

Claims 1-20 are the subject of a Provisional Double Patenting rejection in view of U.S. Patent Application Number 10/613,299. This is not the only basis of rejection of these claims; presently other issues remain in the present application. After these issues are resolved, and the Double Patenting rejection remains, Applicants will consider the advisability of filing a terminal disclaimer.

Rejection Under 35 U.S.C. 103(a)

1. Claims 1,3,4 were rejected under 35 USC 103(a) as being unpatentable over Lane (US Patent 5,148,230) in view of Joline, et al. (U.S. Patent 6,005,696). For at least the reasons that follow, it is respectfully submitted that the noted rejections are improper and that all rejected claims are patentable over the applied art.

An initial requirement of a proper rejection under 35 U.S.C. § 103(a) is that all of the claimed elements be found in the applied art. If a single claimed element is not found in the applied art, a prima facie case of obviousness cannot be properly established.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references themselves or in the knowledge generally available to one of

BEST AVAILABLE COPY

ordinary skill in the art. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

I. Claim 1 is drawn to an optical testing unit for measuring sensitivity of an optical device under test (DUT). The optical testing unit features, inter alia,

⌘...a graphical user interface, which provides an interface with a user⌘

Illustratively Fig. 8 shows the GUI 160, which is described in detail in paragraphs [00064] through [00067] of the filed application. Notably, the GUI 160 provides a point of interaction or communication between a human operator and the optical testing unit. This interaction provides a mutual or reciprocal action or influence between the operator and the GUI 160. For example, the operator may initiate a calibration procedure by selecting discrete selection option 140; and the GUI may provide to the operator the results of the calibration.

The Office Action acknowledges that the reference to Lane, et al. does not disclose a GUI. The Office Action then attempts to cobble elements from the references in order to reconstruct Applicants' invention. To this end, the Office Action asserts that the GUI described in Joline, et al. is properly combinable with the disclosure of Lane, et al. Applicants respectfully disagree. Notably, Joline, et al. discloses a communications network with a plurality of office and a test center. The test center engages the network in order to test certain links in the network. The

BEST AVAILABLE COPY

reference discloses the use of a LAN with a GUI interface on a monitor, personal computer or a workstation in the initiation of a test sequence. Thus, *Joline, et al.* does disclose a GUI and the GUI may be used in testing, but there is no teaching or suggestion to provide the GUI of *Joline, et al.* in an optical testing unit. Stated differently, the reference merely includes a GUI at a PC or other terminal, with the GUI used in a test sequence. The GUI is not part of or is suggested to be part of an optical testing unit.

Furthermore, it is respectfully submitted that the Office Action has improperly combined the teachings of the applied art to produce the claimed invention where there is no teaching, suggestion or motivation to do so found in the references themselves or the or in the knowledge generally available to one of ordinary skill in the art. The reference to *Lane, et al.* discloses a user interface 40' that may be used to generate beginning and end signals. However, there is no teaching, suggestion or motivation to provide a GUI as featured in claim 1 and as described in the filed application. If the motivation provided in the Office Action is knowledge generally available to one of ordinary skill in the art, Applicants respectfully request a citation showing the common nature of the motivation, or an affidavit under 37 C.F.R. 1.104(d)(2). Else, this rejection should be withdrawn.

For at least the reasons set forth above, Applicants respectfully submit that claim 1 and the claims that depend from claim 1, claims 2-9, are patentable. Withdrawal of this rejection is respectfully requested.

2. Claims 2, 5, 10-20 were rejected under 35 USC 103(a) as being unpatentable over *Lane* (US Patent 5,148,230) and *Joline, et al.* (U.S. Patent 6,005,696) in view of *Tanimoto, et al* (US Patent 6,069,697). For at least the reasons set

BEST AVAILABLE COPY

forth herein, it is respectfully submitted that the noted rejections are improper and that all rejected claims are patentable over the applied art.

With particular regard to claims 2 and 5, these claims depend from claim 1, which is patentable over the applied art for the reasons specified above. Therefore, and while in no way conceding that the rejection of claims 2 and 5 is proper, these claims are believed to be allowable over the applied art.

Claim 10 is rejected with reference to the rejection of claim 1. Applicants have refuted the rejection of claim 1 for the reasons set forth above. The Office Action indicates that measuring the bit error rate (BER) would have been known in the art, and it would have been obvious to modify Lane with the known BER method for measuring the BER of a DUT.

As noted previously, an initial requirement of a proper rejection under 35 U.S.C. § 103(a) is that all of the claimed elements be found in the applied art. If a single claimed element is not found in the applied art, a prima facie case of obviousness cannot be properly established. Notably, the Examiner makes a general statement that the BER measuring is known and is thus properly combined with Lane to realize the claimed invention. Respectfully, the Examiner has not provided a basis for either the BER measuring or the motivation to combine this with Lane. Therefore, it is respectfully submitted that the rejection is improper because there is no citation or affidavit from the Examiner under 37 CFR 1.104(d)(2) if from his/her personal knowledge; and because the proper motivation is not provided.

For at least the reasons set forth above it is respectfully submitted that the rejection of claim 10 is improper and should be withdrawn. Therefore, claim 10 is allowable over the applied art; and claims 11-20, which

depend from claim 10 are also allowable.

3. Claims 6, 7-9 were rejected under 35 USC 103(a). These claims depend from claim 1 and for at least the reasons set forth above are thus allowable over the applied art.

Conclusion

In view of the foregoing, applicants respectfully request the withdrawal of the objections and rejections of record, the allowance of all pending claims, and the holding of the application in condition for allowance.

If any points remain in issue, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17. Notably, permission is hereby given to charge the above Deposit Account for the fee required (small entity) for a three-month extension, extending the period of response to December 14, 2005.

BEST AVAILABLE COPY

Respectfully submitted on behalf of
Circadiant Systems, Inc.



by: William S. Francos, Esq.
Attorney for Applicants
(Reg. No. 38,456)

December 14, 2005

Volentine, Francos & Whitt, PLLC
One Freedom Square
11951 Freedom Dr.
Suite 1260
Reston, VA 20190
(571) 283-0720
(610) 375-3513 (Mr. Francos' number in Pennsylvania).